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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,110	02/11/2004	Shigeru Tago	HIRA.0143	3621
7590 Reed Smith LLP Suite 1400 3110 Fairview Park Drive Falls Church, VA 22042-4503			EXAMINER SKIBINSKY, ANNA	
			ART UNIT 1631	PAPER NUMBER
			MAIL DATE 03/14/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/775,110

**Applicant(s)**

TAGO ET AL.

**Examiner**

ANNA SKIBINSKY

**Art Unit**

1631

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4 and 6-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4 and 6-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

Applicants' response, filed 11/30/2007 has been fully considered. Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

#### ***Reply to Applicant's Amendments***

Applicant's amendments to claims 1, 3, 4 and 6-8 are acknowledged. Claims 2 and 5 are cancelled.

#### ***Objection to Claims***

The amendments filed 11/30/2007 are sufficient to over the objection to claims 7 and 8. The objection is hereby withdrawn. Claims 7 and 8 have been amended to depend from claims under examination and are therefor treated on the merits.

#### ***Claim Rejections - 35 USC § 112-1<sup>st</sup> paragraph***

The instant rejection is maintained from the previous Office Action filed 7/30/2007.

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**NEW MATTER**

2. Claims 1, 3, 4, and 6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. This is a New Matter rejection.

3. Applicants have amended claim 1, drawn to a method and claim 4, drawn to a program embedded in a storage medium to recite "said method consisting of" and "said program consisting of". Applicants do not have support in the specification for the method and program to be defined solely by the scope of the claim with respect to what unrecited additional steps or components are excluded from the scope of the claim. For example, the specification recites that in step 801, the user enters a character string representing a base or amino acid sequence and a space is inserted between the character strings representing the individual sequences (page 7, lines 12-20). Additionally, Figure 8 depicts a flow chart of the invention and includes steps such as entering 801, processing 802 the sequences, checking if all of the text data files are processed 808, not included in claims 1 and 4. Furthermore, the instant claims do not include steps of checking if all the text data files have been processed 808 and returning to step 803 (page 8, lines 10-17), checking if identifiers correspond 809 and if not returning to step 806 (page 8, lines 18-23), checking if all of the keywords have been processed 811, and increasing appearance frequency by one 813, of Figure 8. Therefore, the method (and components) of the invention comprise additional steps

(and components) to those recited in claims 1 and 4, thus the amendment reciting "consisting of" is deemed new matter.

***Response to Arguments***

4. Applicant's arguments filed 11/30/2007 have been fully considered but they are not persuasive.
5. Applicants argue (Remarks, page 6, par. 7 to page 7, par.1) that it is apparent to one of skill in the art that the invention can be implemented with just the steps recited in claim 1. Applicants further point to page 9, 2nd to last paragraph of the specification that state that "while the invention has been described by way of an example thereof, the example is illustrative and not restrictive and it will be understood by those of skill in the art that various changes and modifications may be made in the invention without departing from the scope of the appended claims.
6. In response, the specification does include a single example or embodiment of the method "consisting of": a first text document extraction step, an identifier extraction step, a second text document extraction step, an appearance frequency calculation step, and a displaying step. The examples of the method in the specification and drawings include additional steps that are not recited in instant claims 1 and 4. The originally filed claims do provide support for a method consisting of a first text document extraction step, an identifier extraction step, a second text document extraction step, an appearance frequency calculation step but do not provide support for the addition of the displaying step. It is further noted that the understanding of one of skill in the art on how

to implement the method of the instant invention is not equivalent as support for the claims as currently recited. The scope of the instantly recited claims have departed from scope of what was originally filed in the specification and claims, thus the current recitation is deemed to be New Matter.

***Claim Rejections - 35 USC § 112-2<sup>nd</sup> paragraph***

7. The instant rejections are necessitated by amendments filed 11/30/2008.
8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 3, 4, and 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
10. Claim 1, lines 16-17, and claim 4 recites "counting a number of extracted second document data files that contain each keyword". It is unclear how it would be possible to count the recited plurality of extracted second document data files when the instant claim consists of a step of extracting only one second text data file as recited in claim 1, lines 11-12. It is unclear if there should be further second document data file extraction steps in the method, however since the method recites "consisting" the method is closed to the inclusion of further steps.
11. Claim 1, lines 19-20, and claim 4 recite "the tree structure". There is insufficient antecedent basis for the instant limitation. A tree structure was not previously recited in the claim, therefore it is unclear what "the tree structure" refers to.

12. Claim 1, line 22, and claim 4 recites "the lower level". There is insufficient antecedent basis for the instant limitation. A level was not previously recited in the claim, therefore it is unclear what "the level" refers to.

13. Claim 1, lines 34-35, and claim 4 recites "said category table has a tree structure in which keywords are stored and classified into said categories organized in at least one level in said category table, said at least one level includes a lower level". This is vague and indefinite because it is unclear as to what limitation of the method this pertains to. This is not a method step but describes the keyword table and is therefore nonfunctional descriptive material, not given patentable weight.

14. Claim 1 and claim 4 recites a "method consisting" which renders the method closed to further steps however, claim 3 recites further steps in the method.

15. Claim 4 recites a "program consisting" which renders the program closed to other program components however, claim 6 improperly recites yet another program.

### ***Response to Arguments***

16. Applicant's arguments filed 11/30/2007 have been fully considered but they are not persuasive.

17. Applicants argue that "to determine whether to select or change a research course" does not constitute and intended use and have amended the claims to recite "for the user to determine whether to select or change a research course of said base sequence or said amino acid sequence of a gene or protein of interest inputted by a user." Applicants are that the instant limitation indicates the function of the invention.

18. In response, it is noted that the rejection of vagueness or indefiniteness for the instant recitation has been withdrawn. However, it is noted and reiterated that "to determine whether to select or change" and "inputted by a user" are not functional limitations of the claimed method. The instant recitation put forth an intended use, as in "to determine" and nonfunctional descriptive subject matter, as in "inputted by a user".

### ***Conclusion***

1. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anna Skibinsky whose telephone number is (571) 272-4373. The examiner can normally be reached on 8 am - 5:30 pm.



If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran can be reached on (571) 272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Anna Skibinsky, PhD

/Lori A. Clow, Ph.D./  
Primary Examiner, Art Unit 1631  
3/2/08